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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,927	03/31/2004	Sridhar Varadarajan	4544-043812	7917

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Richard L. Byrne
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Pittsburgh, PA 15219-1818

EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,927

Applicant(s)

VARADARAJAN ET AL.

Examiner

Nathan Hillery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communication: Amendment filed on 2/12/07.
2. Claims 17-28 have been examined, with claim 17 being the independent claim.

Claims Rejections – 35 U.S.C. 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 17-28** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation.

Independent claim 17 states in the preamble “A system for generation of presentations” There is no disclosure in the specification supporting an explicit system for generating a presentation; there is no disclosure of hardware, software or even a computer. It is unclear what type of system applicant has invented. The specification describes general steps in an algorithm involving preparation of a presentation, but there is no disclosure supporting the system such that one of ordinary skill in the art at the time of the invention would be taught to make and use the “system” without undue experimentation.

As an example of the human intervention which seems to preclude claiming an system unless applicant intends the system to be claimed to be a human, see figure 3a, and disclosure, page 8, lines 24-27, stating as follows: *"FIG. 3a describes a typical workflow related to APG system. The workflow depicts the activities performed by a user and the major functions of the subsystems of APG system and indicates draft presentation generation and tuning, and the role of best presentations in template generation."* Further, it is noted that throughout the specification, the user is called upon to make quality decisions regarding the form and content of the presentation. For example, see, disclosure, page 10, lines 22-24, stating: *"And both text and graphics are annotated appropriately to capture the salient aspects of the slide. Note that these annotations are done manually and are associated with the slide."* See also, disclosure, page 15, lines 4-8, stating: *"FIG. 15 describes the procedure for the interactive tuning of the generated draft version of a presentation by a user. The input for interactive tuning process is the draft version of a presentation and this process results in the generation of the final version of the presentation (1500). The user analyzes the draft presentation slide by slide and performs Steps 1504 through 1510 for each slide (1502)."*

4. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, first paragraph.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 17 - 28** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claims 17 – 28 are considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus, the latter being the case here.
7. Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer storage medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.
8. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Given the broadest reasonable interpretation to the myriad of loosely defined systems, the Examiner finds that there are many different ways of creating the applicant's invention, as claimed. The specification provides no definitional assistance in narrowing the limitations. Accordingly, in the interest of compact prosecution and art-based examination, the following rejections are based on a possible interpretation of the pending claims as generally directed to a system or method of generating or preparing a presentation, including the following elements drawn from the claim limitations:

- a. an agenda;
- b. audience evaluation;
- c. a presentation template;
- d. a draft of the presentation;
- e. a revision of the draft presentation;
- f. analogies for use in the presentation; and
- g. slides for use in the presentation.

It would have been obvious to one of ordinary skill in the presentation art at the time of the invention that from the elements above, the elements could be related in what could be labeled as sub-systems, and that the combination of the sub-systems would produce a presentation. Said system of sub-systems, under the broadest reasonable

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interpretation, would have been obvious to one of ordinary skill in the art at the time of the invention.

2. Accordingly, **claims 17-28** are rejected under 35 U.S.C. 103(a) as being obvious over Chial, Michael R., Ph.D., "Tips for Building Computer-Based Presentations," University of Wisconsin – Madison, copyright 2002 [hereinafter "Chial"].

Chial teaches the elements of claims 17-28 as follows:

an agenda:

See, Chial, page 2, section 2, "Agenda."

audience evaluation:

See, Chial, page 2, section 2, under "Goals."

a presentation template;

See, Chial, page 4, section 2.A., "Pick a template."

a draft of the presentation;

See, Chial, pages 4-5, section D, "Polish your work for emphasis."

a revision of the draft presentation;

See, Chial, page 5, section E, "Edit your work."

analogies for use in the presentation; and

See, Chial, page 3, section E, teaching using alternative presentations for effect.

slides for use in the presentation.

See, Chial, page 1, second paragraph, teaching computer generated slides.

3. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

10. Applicant's arguments filed 2/12/07 have been fully considered but they are not persuasive.

11. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH



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